

DS 63. (Once Amended) The composition according to claim 62, wherein said composition is in the form of a care product for the body and/or the face and/or the scalp, or a make-up product, in the form of a foundation, a blusher, an eyeshadow, an eyeliner, a mascara or a lipstick.

REMARKS

I. Status of the Claims

Claims 1, 3-19, 23, 25-29, 40, 42-57, 59, 60, and 62-67 are pending in this application. Claim 2 has been canceled without prejudice or disclaimer. Claims 1, 16, 40, 45, and 63 have been amended. Claim 1 has been amended to clarify the process elements. No new matter has been added. Claims 16, 40, and 45 have also been amended to address issues raised by the Examiner under 35 U.S.C. §112, second paragraph. See discussion below. Support for amending claim 16 can be found in the original specification, for example, at page 11, lines 5-7, and page 27. Support for amending claim 40 can be found in the original specification, for example, at pages 15-16. Support for amending claim 45 can be found in the original specification, for example, at page 17, lines 14-15. Claim 63 has been amended to correct a typographical error. No new matter has been introduced by these amendments, nor do the amendments raise new issues or necessitate the undertaking of any additional search of the art by the Office.

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II. Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claims 2, 16, 40, 45, and 63 under 35 U.S.C. § 112, second paragraph, as "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." (Office Action dated February 26, 2002, page 3, lines 17-19.) Applicants respectfully traverse these rejections for the reasons set forth below.

Claim 2

The Examiner has rejected claim 2 as indefinite because the term "staying power" is "not an art-recognized phrase and the specification does not provide a clear and concise definition of it." (Office Action dated February 26, 2002, page 3, lines 20-22.) Applicants have rendered moot this rejection by canceling claim 2 without prejudice or disclaimer. Accordingly, Applicants respectfully request withdrawal of this point of rejection.

Claim 16

The Examiner has rejected claim 16 as indefinite because of the term "PDMSs." (Office Action dated February 26, 2002, page 4, lines 1-3.) Applicants have amended claim 16 to recite "polydimethylsiloxanes (PDMSs)" in accordance with the Examiner's suggestion. For support, Applicants attach to this Reply an excerpt from *Hawley's Condensed Chemical Dictionary* 896 (Richard J. Lewis, Sr., ed., 13th ed. 1997), which defines the term. Thus, Applicants respectfully request withdrawal of this point of rejection, as it is now moot.

Claim 40

The Examiner has rejected claim 40 as indefinite because of the term "hydrocarbon-based" oil. (Office Action dated February 26, 2002, page 4, lines 4-7.) Although Applicants submit that when claim 40 is read in light of the specification, the metes and bounds of the claim are clear, Applicants have removed the term "hydrocarbon-based" from claim 40 and have replaced it with the list of categories of such oils found on page 16, lines 5-6, of the specification. Applicants accordingly request withdrawal of this point of rejection.

Claim 45

The Examiner has rejected claim 45 as indefinite because it contained percent amounts without units. (Office Action dated February 26, 2002, page 4, lines 8-9.) Applicants have amended claim 45 to recite that the percent amount is based on "weight relative to the total weight of the emulsion," as is provided in the specification at page 17, lines 14-15. Applicants accordingly request withdrawal of this point of rejection.

Claim 63

The Examiner has rejected claim 63 as indefinite because of a typographical error. (Office Action dated February 26, 2002, page 4, lines 10-12.) Applicants have amended claim 63 in accordance with the Examiner's suggestion by removing the additional term "in." Applicants therefore request withdrawal of this point of rejection.

III. Rejections Under 35 U.S.C. § 102(b)

The Examiner has rejected claims 1-4, 8, 10, and 11 as anticipated by European Patent No. EP 0 331 833 ("EP '833") under 35 U.S.C. § 102(b) for the reasons set forth on pages 4-5 of the instant Office Action. Claim 2 has been canceled without prejudice or disclaimer, thus, the rejection as to this claim has been rendered moot. Applicants respectfully traverse this rejection for at least the reasons of record and the additional reasons set forth below.

Claims 1, 3, 4, 8, 10, and 11 are directed to processes "for reducing or eliminating the transfer or migration" of a cosmetic, hygiene, or pharmaceutical composition when put to use. For an anticipation rejection to be proper, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." M.P.E.P. § 2131 (citation omitted). Thus, here, the Examiner must show that the cited reference teaches these claimed elements, *i.e.*, for independent claim 1, "a process for reducing or eliminating the transfer or migration... ."

The Examiner has rejected claims 1-4, 8, 10, and 11 because allegedly "[t]he prior art discloses the same amounts of alpha,omega-substituted oxyalkylenated silicone as instantly claimed and, therefore, contain an amount effective for reducing or eliminating the transfer or migration or improving the staying power as instantly claimed of the composition." (Office Action dated February 26, 2002, page 5, lines 11-14 (emphasis supplied).) Even if a composition is taught in the prior art, "[t]he discovery of a new use for an old structure based on unknown properties of the structure might be patentable to the discoverer as a process of using." M.P.E.P. § 2112.02 (citation omitted). A new use of a known composition, if claimed as a process, is patentable

provided that the process is new and unobvious. *In re Zierden*, 411 F.2d 1325, 1329, 162 U.S.P.Q. 102, 104 (C.C.P.A. 1969); *See also Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 875, 228 U.S.P.Q. 90, 99 (Fed. Cir. 1985), *overruled on other grounds*.

In the present case, the Examiner has merely alleged that the emulsions used in the claimed processes are found in the cited reference. The Examiner must, however, show that the claimed processes themselves are obvious or not novel over the cited reference, not that the emulsions used therein are obvious or not novel. Because the Examiner has not shown the processes to be present in *EP '833*, a proper anticipation rejection has not been made. Accordingly, the rejection under § 102(b) should be withdrawn.

IV. Rejection Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-19, 23, 25-29, 40-57 and 59-66 under 35 U.S.C. § 103(a) as obvious over European Patent No. 0 373 661 A2 ("*EP '661*") in combination with European Patent No. 0 796 615 A1 ("*EP '615*"). (Office Action dated February 26, 2002, pages 6-9.) Claim 2 has been canceled without prejudice or disclaimer, thus, the rejection as to this claim has been rendered moot. Applicants respectfully traverse this rejection for at least the reasons below in addition to the reasons of record.

Process Claims

Independent claims 1 and 66 are directed to processes "for reducing or eliminating the transfer or migration" (claim 1) and for the non-therapeutic treatment of

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skin and/or keratin fibers (claim 66). To establish a *prima facie* case of obviousness, the Examiner bears the burden of establishing *at least* that the cited references teach or suggest all of the elements of the claimed invention. M.P.E.P. § 2143 (emphasis supplied). In the present case, the reference combination cited by the Examiner does not teach or suggest all of the claimed elements.

Specifically, the combination of EP '661 with EP '615 does not teach or suggest reduced or eliminated transfer or migration, or non-therapeutic treatment of skin and/or keratin fiber by using an effective amount of α,ω -substituted oxyalkylenated silicone. The Examiner alleges that "[i]t would have been obvious to ... prepare the emulsion of EP '661 using the alpha,omega-substituted oxyalkylenated silicone of EP '615." (Office Action dated February 26, 2002, page 9, lines 1-4.) To properly reject these claims as obvious, however, the Examiner must show that Applicants' claimed processes of using are obvious, not the emulsions employed therein. M.P.E.P. § 2112.02. Accordingly, Applicants respectfully request that the § 103 rejections over the process claims be withdrawn.

Composition Claims

The Examiner has also failed to show that all of the elements of claim 12 (the independent composition claim) are either taught or suggested by the references cited and that there is motivation to combine the references. M.P.E.P. § 2143. The Examiner acknowledges that "EP '661 does not disclose an alpha,omega-substituted oxyalkylenated silicone." (Office Action dated February 26, 2002, page 8, line 1.) The Examiner attempts to cure this deficiency with EP '615, by citing the silicone

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compounds of formulae (I) and (II), which are the preferred compounds of that reference. (Office Action dated February 26, 2002, page 8, lines 6-7.) These silicones, however, are not α,ω -substituted oxyalkylenated silicones, as the oxyalkylene substituents, denoted by the R_2 group, are pendant on the molecule instead of being terminal. (*EP '615*, page 4, line 36 through page 5, line 49.) In fact, *EP '615* discloses five different groups of silicones, of which only one group includes α,ω -substituted oxyalkylenated silicones, those of formula (III). The compounds of formula (III) are not used in any of the six Examples, nor are they identified as being preferred. Further, *EP '661* does not teach or suggest that the silicones disclosed therein could be substituted with α,ω -substituted oxyalkylenated silicones, nor the α,ω -substituted oxyalkylenated silicones of claim 12. Thus, of all the silicones disclosed in *EP '615*, the Examiner has not shown that Applicants' α,ω -substituted oxyalkylenated silicones are taught therein, nor why one of ordinary skill in the art would have selected such compounds for combination with *EP '661*. Applicants submit that selecting α,ω -substituted oxyalkylenated silicones of claim 12 from *EP '615* would require picking and choosing with the aid of hindsight as guidance, which is improper.

As the Examiner has not demonstrated that all of the elements of Applicants' claim 12 are taught or suggested by the cited reference combination, nor that the combination is proper, Applicants respectfully request that this rejection be withdrawn.

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V. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 5, 2002

By: 

Michele L. Mayberry
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Attachment: Appendix to Amendment
Excerpt from *Hawley's Condensed Chemical Dictionary*

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APPENDIX TO AMENDMENT OF JUNE 5, 2002

Version with markings to show changes made

IN THE CLAIMS:

Please cancel claim 2, and replace claims 1, 16, 40, 45, and 63 with amended claims 1, 16, 40, 45, and 63, as follows:

1. (Three times amended) A process for reducing or eliminating the transfer or migration of a cosmetic, hygiene, or pharmaceutical composition when put to use, said process comprising introducing into said composition ~~comprising introducing into a cosmetic, hygiene or pharmaceutical composition~~ an emulsion comprising at least one α,ω -substituted oxyalkylenated silicone in an amount effective for reducing or eliminating the transfer or migration of said composition when put to use, wherein said emulsion has a dynamic viscosity ranging from 100 mPa.s to 20 Pa.s, this viscosity being measured on a Rheomat 180 from Mettler using a Spindle No. 2 at 25°C, at a shear rate of 200s⁻¹, and at time t=10 minutes.

16. (Once Amended) The emulsion according to claim 15, wherein said pigments are chosen from titanium dioxide, zirconium dioxide, cerium dioxide, zinc oxide, iron oxide, chromium oxide, ferric blue, pearlescent agents, coloured titanium mica, carbon black, barium, strontium, calcium and aluminium lakes, pigments coated with at least one silicone compound ~~chosen from PDMSs~~ chosen from polydimethylsiloxanes (PDMSs), and pigments coated with polymers.

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APPENDIX
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40. (Once Amended) The emulsion according to claim 12, wherein said fatty phase further comprises at least one ~~hydrocarbon-based~~ oil chosen from oils of plant origin, oils of animal origin, oils of mineral origin, oils of synthetic origin, fluoro oils, and triglycerides of C₁₂-C₁₈ fatty acids in an amount up to 40% by weight relative to the total weight of the fatty phase of the emulsion.

45. (Once Amended) The emulsion according to claim 44, wherein said active principles are present in a proportion ranging from 1 to 15% by weight relative to the total weight of the emulsion.

63. (Once Amended) The composition according to claim 62, wherein said composition is in the form of a care product for the body and/or the face and/or the scalp, or a make-up product, ~~in~~ in the form of a foundation, a blusher, an eyeshadow, an eyeliner, a mascara or a lipstick.

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